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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/595,515 06/15/00 SHANNON

J KINGP.55031

EXAMINER

MMC2/1109

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ART UNIT

PAPER NUMBER

2859

DATE MAILED:

11/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/595,515

Applicant(s)
SHANNON et al.

Examiner
Andrew Hirshfeld

Group Art Unit
2859



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 16-35 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 16-35 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Jun 15, 2000 is ☒ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Priority

1. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application in the first sentence of the specification (37 CFR 1.78).

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on June 15, 2000 have been approved.

Claim Objections

3. Claims 30,31 and 33 are objected to because of the following informalities:

In claim 30: In line 1, "new" should be deleted, since a claim should not refer to purported merits of an invention. See also claim 33, line 1, which also includes the term "new".

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

4. Claims 16-32,34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16: In line 4, the meaning of "said thickness and being" is not clear. In line 12, there is no antecedent basis for "said second end". In the last line of the claim, the meaning of the phrase "when the book is inserted therein" is not clear. Perhaps "book" should be replaced with --bookmark--.

In claim 30: This claim is indefinite, since it does not positively locate the top stop and the bottom stop relative to the connector.

In claim 32: In line 4, the meaning of "said thickness and being" is not clear. In line 10, the term "complementing" renders the claim indefinite, since the specification and claims do not set forth criteria for determining when the bottom anchor complements the top anchor. For example, are two identical elements complimenting? Are elements of the same color "complimenting"? In the last line of the claim, the meaning of the phrase "when the book is inserted therein" is not clear.

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In claim 34: In line 4, the meaning of "said thickness and being" is not clear. In line 14, the meaning of the phrase "when the book is inserted therein" is not clear.

In claim 35: In line 4, the meaning of "said thickness and being" is not clear. In line 14, the meaning of the phrase "when the book is inserted therein" is not clear.

Double Patenting

5. Applicant is advised that should claim 34 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Similarly, should claim 35 be found allowable, claim 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16,18-25,28,32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane.

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Bailey et al. teaches a bookmark having a flexible, elastic intermediate member or ribbon C having opposed ends. Hooks (anchors) c are attached to each of the ends.

Bailey et al. does not teach the anchors including features of a character.

Crane teaches a bookmark having an intermediate member or ribbon with a predetermined length and width and a loop. A first abutment member in the form of a woman's head is attached to a first end of the intermediate member, and a second abutment member in the form of legs is attached to a second end of the intermediate member. When the bookmark is used with a book, the abutment members have a thickness in a direction substantially perpendicular to the length of the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bailey et al. by adding the first abutment member of Crane to the top hook of Bailey et al., and adding the second abutment member of Crane to the lower hook of Bailey et al., since Crane teaches that providing a bookmark with upper and lower character portions is beneficial for increasing the aesthetic appeal of the bookmark.

With specific regard to claim 19, the depictions of Crane are considered to be "cartoon character features", since it is

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clear that the broad class of cartoons can include the depictions of Crane.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to additionally modify Bailey et al. by including an upper torso and limbs with the first abutment member and by including a lower torso with limbs with the second abutment member, as a choice of design, for the purpose of making a more appealing bookmark. One it is known to utilize parts of a human for the decorative effect of a bookmark, it is merely a choice of aesthetic design to include additional parts of the human body.

With specific regard to claims 23 and 28, since the intermediate member can be coiled around the lower limbs of the proposed modified device of Bailey et al., the lower limbs are considered to be constructed to retain a coiled portion of said intermediate member therebetween.

With regard to the top and bottom anchors being "plush", such would have been obvious to one having ordinary skill in the art at the time the invention was made, since it is clear that "plush" abutments would be beneficial since they would not scratch or otherwise mar objects while the bookmark is in use.

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With regard to claims 25 and 33, the hooks of Bailey et al. are constructed for releasable engagement with each other, since they can be hooked together if desired. Also, with regard to claim 33, the preamble and the functional language "may be wrapped around an individual's wrist..." are not sufficient to set forth sufficient structure to patentably distinguish the claimed invention from the prior art.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16,18-25,28,32 and 33 above, and further in view of Ward et al.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16,18-25,28,32 and 33, except for the intermediate member being made from an elastomeric material.

Ward et al. teaches a bookmark with an elastomeric band A, a plurality of hooks on the band, and a line indicator on the band.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by replacing the intermediate member thereof with the elastic band of Ward et al., since Ward et al. teaches that

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an elastomeric band is suitable for bookmarks that require stretching to accommodate books of various size. This proposed modification can result in the intermediate member being round as taught by Bailey et al., or flat as taught by Ward et al.

9. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16,18-25,28,32 and 33 above, and further in view of Cox.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16,18-25,28,32 and 33, except for the first and second abutments being three-dimensional.

Cox teaches a book marker with a three dimensional ornamental element thereon. The element is in the form of a human face.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by making the first and second abutments three-dimensional, since Cox teaches that three dimensional ornamental elements are known for providing a desired ornamental effect.

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Allowable Subject Matter

10. Claims 34 and 35 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. Claims 26 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

13. In response to applicant's argument that the device of Bailey et al. is not a bookmark, the device of Bailey et al. is an indicator for a book and is therefore a bookmark. With regard to the structure which applicant states is necessary for a bookmark, this structure is met by the device of Bailey et al. as modified by Crane, as set forth above.

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14. Applicant has argued that the device of Bailey et al. is used in a different manner than the claimed invention. The examiner does not contend this point. However, an invention is defined by structure rather than the intended use of the structure. Since the claimed structure of applicant's invention is rendered obvious by Bailey et al. in view of the secondary reference(s) (as set forth above), the art rejections of the claims are proper.

15. In response to applicant's argument that Crane does not teach abutment members since Crane is a design patent showing, this argument is also directed to the intended use of applicant's invention, rather than the structure of the invention. As stated above, the intended use of an invention is not sufficient to patentably distinguish the claimed invention from the prior art, since the intended use does not set forth structure of the invention.

16. With regard to the combination of Bailey et al. and Crane, the examiner disagrees with applicant's assertion that mere ornamentation is not a reason or motivation to add the elements

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of Crane to Bailey et al. Crane teaches that ornamental elements are beneficial for making an item more appealing to a user. One having ordinary skill in the art would recognize that these ornamental features would improve the device of Bailey et al. by making it more appealing.

17. With regard to claims 23 and 28 and applicant's argument that Bailey et al. does not suggest that it could be coiled about an abutment, the coiling feature of the claimed invention is met by an elastic member capable of being wrapped at least once around the abutment. This would be inherent in Bailey et al. as modified by Crane, since the elastic member of Bailey et al. could be wrapped at least once around one of the lower limbs of Crane. Although Bailey et al. teaches use of a sleeve E, this sleeve would not prevent the elastic member from being wrapped around the lower limb at least once.

18. With regard to applicant's argument that Bailey et al. does not teach joining the hooks together when the indicator is removed from the book, this argument is moot since applicant is not claiming the fastening members as being fastened together.

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Rather, applicant is claiming the fastening members being capable of being fastened together, which is shown by Bailey et al.

19. In response to applicant's arguments against Ward et al., one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

20. In response to applicant's argument that the three dimensional feature of Cox is not an abutment, Cox is being relied upon for its teaching regarding use of a three dimensional element on a bookmark. When a three dimensional element is placed on a bookmark it is inherent that this element would function as an abutment.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Andrew Hirshfeld whose telephone number is (703) 305-6619.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956.



Andrew Hirshfeld
Primary Examiner
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November 9, 2000